

Docket No.: IA 1502.01A US
USSN: 09/296,202

PATENT
Art Unit: 3621

REMARKS

Claims 1-19 are pending in the present application.

This Amendment is in response to the Office Action mailed November 10, 2003. In the Office Action, the Examiner rejected claims 1-19 under 35 U.S.C. § 102(a). Applicant has amended claims 1, 7, and 12 to correct some minor informalities. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-19 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,822,291 issued to inventor Brindze et al. ("Brindze"). Applicant respectfully traverses the rejection for the following reasons.

Brindze discloses a mass storage device that removably supports a mass storage element and includes a data head having an output for reading tracks of main data elements (Col. 1, lines 53-56). Brindze further discloses an auxiliary storage media on a substrate that has a unique machine-readable serial identifier. The mass storage element can be a compact disk, the drive means including means for rotating the disk (Col. 1, lines 63 to Col. 2, lines 38). Unlike the present invention, Brindze does not disclose tracking an electronic storage medium while being shipped between various entities using a tracking identifier.

Brindze does not disclose, suggest, or render obvious the tracking of an electronic storage medium while being shipped between various entities using a tracking identifier.

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To support a 102 rejection, the Examiner must show that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bro. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). (MPEP §2131). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (MPEP §2131). Here the Examiner has not pointed out the specific language in Brindze that teaches the tracking of an electronic storage medium while being shipped between various entities using a tracking identifier.

Since the Examiner has failed to show the identical invention in as complete detail as is contained in the claim, the rejection under 35 U.S.C. §102(a) was improperly made. Therefore, Applicant respectfully requests that rejection be withdrawn.

Please note that, in preparing this Response, Applicant has fully considered the cited reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by this reference. However, the cited reference does not teach, disclose, suggest, or render obvious the "tracking of an electronic storage medium while being shipped between various entities using a tracking identifier."

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CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

Respectfully submitted,

DISCOVISION ASSOCIATES

Dated: February 10, 2004


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